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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,367	11/08/2001	David H. McDaniel	509582000221	5657

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EXAMINER

FARAH, AHMED M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/986,367

Applicant(s)
David McDaniel

Examiner
A. Farah

Art Unit
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the drawings filed on July 31, 2002 include Figures 1A , 1B and Figures 2A, 2B. However, the Brief Description of the Drawings refers only to Figure 1 and Figure 2. Correction is required. See MPEP § 601.0(g).

Double Patenting

2. Claims 1-9 and 15 provisionally rejected under the judicially created doctrine of double patenting over claims 7-10 of copending Application No.09/819,081. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a method for stimulating hair growth by applying photomodulation enhancing agent to a surface of skin containing hair, and exposing the skin to electromagnetic radiation so as to stimulate hair growth.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

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application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tankovich et al. U.S. Pat. No. 6,050,990.

Tankovich et al. disclose methods and devices for applying laser light to the skin of a patient, including methods for removing hair, for synchronizing hair growth, and for stimulating hair growth (see the abstract).

As to claims 1, 3, 10, 12, 15 and 16, their methods for stimulating hair growth comprise the steps of: selecting at least one photomodulating agent **14** having an average diameter enabling the agent to penetrate the hair duct (see Fig. 17), the agent selected from a group consisting a dye and other photomodulating agents (Col. 9, lines 38-44); applying the agent to a skin section

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containing hair (see Fig. 22); and exposing the skin and the agent to electromagnetic radiation having a wavelength of about 1064 nm (see Col. 11, line 3).

As to claim 2, the photomodulating agent is applied to the skin prior to irradiation.

As to claims 4-7, ultrasonic energy is applied to the skin surface 12 to force the photomodulating agents into the hair ducts (see Fig 23 and Col. 39, lines 10-13).

As to claims 8 and 11, the electromagnetic radiation source is selected from the group consisting of an ultrasound radiation emitter, a laser (Col. 10, line 27), and a flashlamp (Fig. 35 and Col. 8, lines 48-64).

As to claims 9 and 13, the photomodulating agent has an absorption characteristic including an absorption maxima at a wavelength equal to the wavelength of radiation source. See Col. 9, lines 35-38.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

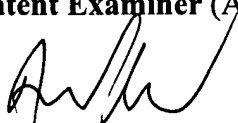
U.S. Patent 6,283,956 to McDanniel; U.S. Patent 5,752,949 to Tankovich et al.; U.S. Patent 5,647,866 to Zaias et al.; and U.S. Patent 5,766,214 to Mehl, Sr. et al.; teach, respectively, methods of producing preferential damage to hair by applying photoactive agent to the skin and then exposing the skin to an electromagnetic radiation, the agents having an absorption maxima at a wavelength equal to a wavelength of the respective radiation sources.

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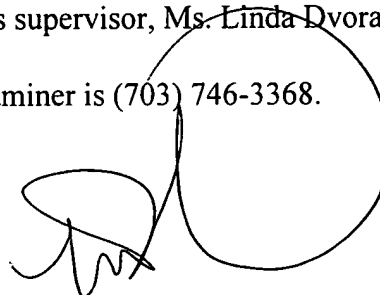
Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

A. M. Farah

Patent Examiner (Art Unit 3739)



December 13, 2002



Linda C. M. Dvorak

Supervisory Patent Examiner